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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/834,912	04/07/97	WASHINO	K FNI-02202/03

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EXAMINER

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ART UNIT	PAPER NUMBER
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2713

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/834,912

Applicant(s)

Washino

Examiner

Vu Le

Group Art Unit

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☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 7-9 and 14 are objected to because of the following informalities:
  - a. Claim 1, line 3, change “an input to receive a signal” to --means for receiving an input signal--. Otherwise, it’s not clear if the language referring to “an input” or “a means to receive an input”;
  - b. Claim 1, line 11, before “program”, change “a” to --the audio/video--;
  - c. Claim 1, line 14, change “a” to --the audio/video--;
  - d. Claim 1, line 15, after “input”, insert “means”;
  - e. Claim 1, line 19, change “the program” to --the audio/video program--;
  - f. Claim 7, line 3, after “respect to”, change “a” to --the--;
  - g. Claim 8, line 4, before “program”, change “a” to --the--;
  - h. Claim 8, line 6, change “input format” to --input display format--;
  - i. Claim 9, line 4, before “program”, change “a” to --the--;
  - j. Claim 9, line 6, change “input format” to --input display format--;
  - k. Claim 14, line 13, after “input”, insert “receiving means”;

Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

2. Claims 10, 12 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 10, line 3, "sufficient capacity to store at least 120 minutes..." is indefinite, for example, to what the maximum bound?

b. Claim 12, line 3, is "a program" referring to the input program?

c. Claim 14, line 8, the condition "if necessary" is indefinite. What happens if it's not necessary?

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

**Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).**

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4. Claims 1-28 are rejected under the judicially created doctrine of double patenting over claims 1-25 of U. S. Patent No. 5,537,157 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

**[see claims 1, 14 and 20 of the patent]**

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Washino et al, US Pat. No. 5,537,157.

Washino et al discloses the following limitations as claimed:

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a multi-format audio/video production system adapted for use with a display device (fig.

3) comprising:

an input (84) to receive a signal representative of an audio/video program in one of a plurality of display formats;

high-capacity video storage means including an asynchronous program recording and reproducing capability (70);

an operator control (fig. 3 discloses a microprocessor 74, which is a PC-based system, see col. 9, lines 1-9, thus, an operator control such as a mouse is inherently included); and

a graphics processor (82) in communication with the input (84), the high-capacity video storage means (70), and the operator control (i.e., through microprocessor 74), enabling a user to perform the following functions:

convert the display format of a program received through the input into an intermediate production format (see col. 10, lines 23-38);

perform a frame-rate conversion of a program received through the input using the asynchronous recording and reproducing capability associated with the high-capacity video storage means (see fig. 6; col.12, lines 24-39);

output a program having a display format or frame rate different than that of the program received through the input (again, see fig. 6; see also col. 4, lines 6-37).

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Regarding claim 2, the multi-format audio/video production system of claim 1, wherein the graphics processor is operative to output a program in a standard television format regardless of the display format of the input program (see fig. 6; col. 12, lines 24-39).

Regarding claim 3, the multi-format audio/video production system of claim 1, wherein the graphics processor is operative to output a program in a widescreen format regardless of the display format of the input program (see fig. 4, 120; col. 10, lines 11-15).

Regarding claims 4-5, the multi-format audio/video production system of claim 1, wherein the graphics processor is operative to output a program in an enhanced-definition format regardless of the display format of the input program (see fig. 4, 124; col. 10, lines 23-38).

Regarding claim 6, the multi-format audio/video production system of claim 1, wherein the graphics processor is operative to output a program in a film-compatible format regardless of the display format of the input program (see fig. 4, 128; col. 11, lines 49-60).

Regarding claim 7, the multi-format audio/video production system of claim 1, wherein the graphics processor is further operative to perform a pan/scan operation with respect to a program received through the input (see col. 4, lines 23-28).

Regarding claims 8-9 and 15, the multi-format audio/video production system of claim 1, wherein the graphics processor is further operative to perform an interpolation operation with respect to a program received through the input so as to expand/reduce the number of pixels associated with the production format as compared to the input format (see col. 10, lines 34-38).

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Regarding claim 10, the multi-format audio/video production system of claim 1, wherein the high-capacity video storage means includes sufficient capacity to store at least 120 minutes of program material to perform the frame-rate conversion (see col. 8, lines 29-38).

Regarding claim 11, the multi-format audio/video production system of claim 1, including high-capacity video storage means in the form of a removable medium (see fig. 3, 70 or fig. 4, 104).

Regarding claim 12, the multi-format audio/video production system of claim 1, further including means for performing a data compression operation on a program prior to storing the program in the high-capacity video storage means (see fig. 7, 222; col. 12, lines 21-23; col. 13, lines 34-39).

Regarding claim 13, the multi-format audio/video system of claim 1, wherein the intermediate production format is based upon a frame rate of 24 frames per second (see figs. 1a-1d; col. 5, line 1 through col. 6, lines 1-24).

Regarding claims 14 and 18, which are an extension of claim 1, but include the method steps, and are part of a general purpose computer that includes a color display, and wherein the graphic processor converts the production format (24 fps) into the following formats, NTSC at 30 fps, PAL/SECAM at 25 fps, HDTV at 25 fps, HDTV at 30 fps, film-compatible video at 24 fps, and film-compatible video at 30 fps. (see figs. 1a-1d; fig. 6; col. 9, lines 1-15; col. 10, line 11 through col. 12, lines 1-39; the color display is inherent; grounds for rejecting claim 1 also applies to claims 14 and 18).



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Regarding claims 16-17 and 24, the multi-format audio/video production system of claim 14, wherein the asynchronous program recording and reproducing capabilities are used to increase the frame rate from the 24 fps production format frame rate to a 25 fps output frame rate (see fig. 6; col. 12, lines 24-39).

Regarding claim 19, the method of claim 18, further including the step of interpolating the video program in the production format to output an edited version of the program having pixel dimensions greater than that of the production format (see grounds for rejecting claims 8-9 and 15 above).

Regarding claim 20, the method of claim 18, further including the step of controlling pan/scan operations relative to the received input video program (see ground for rejecting claim 7 above).

Regarding claim 21, the method of claim 18, herein the high-capacity video storage means includes sufficient capacity to store at least 120 minutes of program material (see ground for rejecting claim 10 above).

Regarding claim 22, the method of claim 18, further including the step of providing a removable high-capacity video storage medium (see ground for rejecting claim 11 above).

Regarding claim 23, the method of claim 18, further including the step of data compressing the video program in the production format (see ground for rejecting claim 12 above).

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Regarding claims 25-26, the method of claim 17, wherein the step of manipulating the video program in the production format further includes the step of performing an interpolation operation on a received so as to expand/reduce the number of pixels associated with the production format as compared to the input format (see ground for rejecting claims 8-9 above).

Regarding claim 27, the method of claim 17, wherein the step of manipulating the video program in the production format includes the step of panning and scanning the vision center of the displayed program (see ground for rejecting claim 7 above).

Regarding claim 28, the method of claim 17, wherein the step of manipulating the video program in the production format includes the step of providing predetermined criteria used to restrict the viewing of the program (see col. 5, lines 28-44).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Vu Le whose telephone number is (703) 308-6613 and email is "Vu.Le@uspto.gov". The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tommy Chin, can be reached on (703) 305-4715. The fax number for submitting formal communications is (703) 308-9051, and for informal communications is (703) 308-5399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

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Patent Examiner

A handwritten signature in black ink, appearing to be 'Vu Le/VL', written in a cursive style.

Vu Le/VL  
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